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APPLICATION FOR PATENT TERM ADJUSTMENT 37 C.F.R. § 1.705(d)

Applicants : Goddard, et al.
Patent No. : 7,423,119
Issued : September 9, 2008
For : SECRETED AND
TRANSMEMBRANE
POLYPEPTIDES AND NUCLEIC
ACIDS ENCODING THE SAME
Examiner : Romeo, David S.
Conf # : 4531

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

After review of the file history and Image File Wrapper (IFW), Applicants hereby submit this Application for Patent Term Adjustment (PTA) to correct the Office's PTA calculation of 394 days. The above-referenced patent issued on September 9, 2008, and therefore this application under 37 C.F.R. § 1.705(d) is timely filed within two months of the issue date.

Applicants submit they are entitled to a longer period of patent adjustment under 35 U.S.C. § 154(b) in light of the decision in *Wyeth v. Dudas*, No. 07-1492 (JR) (D.D.C. Sept. 30, 2008), and request that the Office recalculate Applicants' PTA in accordance with that ruling.

Applicants believe the available PTA to be **839 days** based on the following facts:

1. Applicants believe they are entitled to **605 days** of PTA under **35 U.S.C. § 154(b)(1)(A)**. This provision provides a one-day extension of patent term for every day that issuance of a patent is delayed due to enumerated prosecution delays by the Office (hereinafter, "prosecution delays"). Applicants' PTA calculation under 35 U.S.C. § 154(b)(1)(A) is represented in the table below.
2. The Office's PTA determination listed on the face of the patent does not properly account for PTA under 35 U.S.C. § 154(b)(1)(B), however. Applicants submit that, in light of *Wyeth v. Dudas*, they are entitled to an additional **383 days** of PTA under **35 U.S.C. § 154(b)(1)(B)**, for the Office's failure to issue a patent within three years

of the application filing date. Section 154(b)(1)(B) provides a one-day extension for every day greater than three years after the application filing date that it takes for a patent to issue ("issuance delay"), subject to some limitations. One such limitation is the filing of an RCE, because the § 154(b)(1)(B) patent term adjustment calculation does not include any time consumed by continued examination of the application requested by the applicant. 35 U.S.C. § 154(b)(1)(B)(i). Thus, the applicable time period to determine Applicants' § 154(b)(1)(B) PTA is the day after the date that is three years after Applicants' application filing date, May 4, 2005, to the date Applicants filed the first RCE, May 22, 2006.

3. The § 154(b)(1)(B) PTA period, May 4, 2005 to May 22, 2006, encompasses 383 days. This 383-day delay should be reduced by any "prosecution delay" days that also occurred in this period to avoid double-counting overlapping days. In this case, however, there are no "overlapping days," because the Office's 103-day delay in issuing the patent after payment of the issue fee occurred *after* May 22, 2006, the end of the § 154(b)(1)(B) PTA "issuance delay" period. Thus, Applicants submit they are entitled to 383 days of "issuance delay."
4. Applicants filed a Request for Reconsideration of Patent Term Adjustment on September 29, 2008. This Request asked the Office to reconsider its determination that Applicants' letter of good faith and candor filed on January 29, 2008 constituted a miscellaneous incoming letter, reducing the PTA by 63 days. The Request explains that a letter filed to satisfy Applicants' duty of candor and good faith does not constitute a failure to engage in reasonable efforts to conclude prosecution under 37 C.F.R. § 1.704, and thus the reduction of PTA by 63 days was improper. Applicants have not received a response to the September 29, 2008 Request to date. In anticipation of a favorable decision on Applicants' September 29, 2008 Request, however, Applicant delay under 35 U.S.C. § 154(b)(2)(C)(i), represented in the table below, does not include the 63-day delay.
5. Under *Wyeth*, the proper patent term adjustment is the sum of "prosecution delays" and "issuance delays," minus any Applicant delay. Thus, Applicants submit they are entitled to the sum of 605 days of "prosecution delay" and 383 days of "issuance delay," minus 149 days of Applicant delay, for a **total patent term adjustment of 839 days.**

Applicants' PTA calculation is as follows:

Actions Under 35 U.S.C. § 154(b)(1)(A)		Delays		
Initial	Responsive	PTO	App	Over
5/03/2002 Filing Date	11/16/2004 Non-Final Office Action	502		
11/16/2004 Non-Final Office Action	5/02/2005 Response After Non-Final Action		75	
5/02/2005 Response After Non-Final Action	7/13/2005 Information Disclosure Statement		72	
7/26/2005 Final Rejection	10/27/2005 Notice of Appeal Filed		1	
8/08/2006 Final Rejection	11/09/2006 Second Request for Continued Examination (RCE)		1	
1/29/2008 Issue Fee Payment	9/09/2008 Issuance Date	103		
Actions Under 35 U.S.C. § 154(b)(1)(B)		PTO	App	Over
5/3/2005 3 Years from Filing Date	5/22/2006 First Request for Continued Examination (RCE)	383		
Actions Under 35 U.S.C. § 154(b)(1)(A) and (B)		Delay & Overlap		
Totals	PTO Delays	988		
	Applicant Delays		149	
	Period of Overlap			0
	Patent Term Adjustment	839		

The present application is not subject to a terminal disclaimer.

Applicants hereby request that the Office correct the calculation of PTA to reflect 839 days.

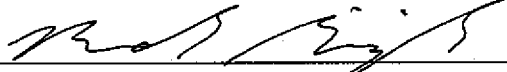
The \$200 fee prescribed by 37 CFR 1.18(e) is enclosed.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 11/6/08

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